

Remarks

With respect to the claims, Applicants have amended independent claim 1 so as to address the Examiner's concerns under §112 para 2. The Examiner has withdrawn claims 2-8, 16-19, and 25. Claim 26 has been amended to depend from Claim 1. Should the Examiner find amended claim 1 to be allowable, applicants request reconsideration to rejoin method claims 16-19. Should the Examiner reconsider rejoining method claims 16-19, Applicants respectfully request that method claims 16-19 be amended to also include amended claim 26 as a heterologous fusion protein contemplated for the method claims. Applicants have added new claims 27-34 that provide additional limitations to Claims 1 and 26. Claims 27 and 28 are mirror images of Claims 1 and 26 except that Claims 27 and 28 have "consisting" language instead of "comprising" language. Claim 29 is the heterologous fusion protein of claim 28 that is encoded by a specific DNA molecule (SEQ ID NO. 20). Claims 30-34 are dependent claims wherein the fusion proteins are glycosylated

Support for the amendments can be found throughout the specification, but especially on page 6, lines 5 to 8, page 6, lines 8 to 14, page 7, lines 8 to 13, page 7, lines 15 to 25, page 8, lines 26 to 28, page 9, lines 2, 3 and 11, to page 13, lines 13 to 15, and Examples 1 to 7. Support for the new claims can be found throughout the specification, but especially on page 6, lines 24 to 25, and page 13, lines 13 to 31.

REJECTION UNDER 35 U.S.C. § 112 para. 2

The Examiner rejected Claim 1 and 26 under 35 U.S.C. §112 para 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended the claims so as to make clear that the GLP-1 analog is fused to peptide linker which is fused to Fc portion (i.e the configuration and sequence of the 4th compound listed in table 1; line 19 of page 22).

(Gly8-Glu22 -GLP-1(7-37)-IL-IgG4 (S228P, F234A, L235A)

Thus this rejection should now be rendered moot.

Double Patenting

Applicants note that the Examiner has provisionally rejected Claim 1 and 26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/558862. Without conceding the basis for this rejection and reserving the right to later rebuttal, Applicants submit herewith a terminal disclaimer pursuant to 37 C.F.R. 1.321(c) and 37 C.F.R. 1.130(b) disclaiming any term of a patent granting on the instant application extending beyond the term of a patent granting from copending Application No. 10/558862.

Serial No. 10/558,627
Docket No. X-15984

SUMMARY AND CONCLUSION

Applicants respectfully assert that the application is now in condition for allowance. The specific GLP-1 fusion protein as claimed is definite. If, for any reason, the Examiner feels that a telephone conversation would be helpful in expediting the prosecution of this case, the Examiner is urged to call me.

Respectfully submitted,

/Gregory A. Cox/
Gregory A. Cox
Attorney for Applicants
Registration No. 47504
Phone: 317-277-2620

Eli Lilly and Company
Patent Division/GAC
Lilly Corporate Center
Indianapolis, Indiana 46285

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